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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re application of:	Bates, et al.
Serial No.:	09/291,245
Filed:	April 13, 1999
For:	METHOD AND COMPUTER PROGRAM PRODUCT FOR IMPLEMENTING WEB BASED DOCUMENT PRINTING
Group Art Unit:	2622
Confirmation No.:	1843

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF IN SUPPORT OF APPEAL
FROM THE PRIMARY EXAMINER TO THE BOARD OF APPEALS

Sir:

Applicant(s) herewith submit an appeal brief, in triplicate, in support of its appeal to the Board of Appeals from the decision of the Primary Examiner dated September 27, 2002, finally rejecting claims 1-16.

The appeal brief fee of $320.00 is:

___ Enclosed.

___ Not required. (Fee paid in prior appeal.)

_X_ Charged to Deposit Account No. **09-0465**. A duplicate copy of this sheet is enclosed.

Docket No.: RO998-223
Serial No.: 09/291,245

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This is an appeal of a Final Rejection of claims 1-26 of Application Serial No. 09/291,245, filed April 13, 1999. This brief is submitted pursuant to a Notice of Appeal filed September 22, 2003, as required by 37 C.F.R. §1.192.

1. Real Party in Interest

The real party in interest is International Business Machines, Inc., the assignee of the above-identified application.

2. Related Appeals and Interferences

There are no related appeals or interferences for the above-identified application.

3. Status of Claims

The present application is a Continued Prosecution Application ("CPA") of a U.S. Patent Application filed April 13, 1999. In a final office action in the parent application, the Examiner: (i) rejected claims 1-13, 16 and 19-26 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,061,700 to Brobst et al ("Brobst"); and (ii) rejected claims 14-15 and 17-18 under 35 U.S.C.§ 103(a) as being unpatentable over Brobst in view of US Patent 6,320,671 to Kelley et al ("Kelley"). Both Brobst and Kelley were commonly owned by the assignee of the present application at the time the invention was made.

To overcome the final rejection in the parent case, Appellant filed a Continued Prosecution Application ("CPA") on May 12, 2003 to invoke the changes made to 35 U.S.C. §103(c) by the American Inventors Protection Act of 1999 ("AIPA"). Applicant then filed a Preliminary Amendment on May 19, 2003 that: (i) amended claims 14-15 and 17-18 to include the base claim and all intervening dependent claims; and (ii) addressed the Examiner's rejection of claims 1-13, 16 and 19-26 under 35 U.S.C. §102(e) as being anticipated by US Patent 6,061,700 to Brobst et al. Shortly thereafter, the Examiner issued a new Final Office Action rejecting all of the claims. Unfortunately, this Office Action did not address the Amendments filed May 19 or the AIPA issues. See *May 20 Office Action Summary.*

In response to the May 20 Final Office Action, Applicant resubmitted the May 19 Amendment on August 20, 2003. Applicant has not received an indication whether or not the May 19 or August 20 filings have been entered, either via an advisory action or in response to repeated telephone inquiries. If the May 19 or August 20 filings have not been entered, Appellant has re-submitted the May 19 amendment herewith under MPEP §1207. Appellant believes that entry will simplify the issues for this Appeal, namely to separate the issues surrounding the §103(a) rejections from the issues surrounding the §102(e) rejections.

4. Status of Amendments

Appellant filed an Amendment on May 19, 2003 and August 20, 2003, and has submitted herewith an Amendment under MPEP §1207. Appellant is unsure of the status of these Amendments.

5. Summary of Invention

A method, apparatus and computer program product are provided for implementing web based document printing. In one aspect, a document originator specifies a document print index. User selected uniform resource locators (URLs) in the document print index are then identified. and sequentially printed. The print index stores a list of user selected uniform resource locators (URLs) to be printed. A web based printing program utilizes the stored print index for printing a document including the list of user selected uniform resource locators (URLs).

6. Issue

The Examiner has rejected claims 1-13, 16 and 19-26 under 35 U.S.C. §102(e) as being anticipated by Brobst and rejected claims 14-15 and 17-18 under Brobst in view. The first issue is whether the Examiner is correct in asserting that claims 1-13, 16, and 19-26 are anticipated by Brobst. The second issue is whether the Examiner established the required prima facie case of obviousness for claims 14-15 and 17-18 in view of 35 U.S.C. §103(c).

7. Grouping of Claims

Appellants expressly state that the rejected claims do not stand or fall together. Appellants have grouped the claims to parallel the Examiner's rejections and have organized this brief accordingly. Reasons why each claim group is separately patentable are provided in the Argument section of this Appeal Brief.

8. Argument

I. Claims 1-13, 16, and 19-26

To anticipate under section 102, a single reference must teach each and every element or step of the rejected claim. In this case, the web page selection mechanism 540 of Brobst is used to create a list of user selected and related web pages. The web page storing mechanism 550 stores the list of selected and related web pages in a URL format and conglomeration mechanism takes the selected URLs, and then formats them into a flattened web page. Claims 1-13, 16 and 19-26, in contrast, recite that the print index is explicitly specified by a web based document originator. Appellants respectively submit that his feature of the present invention is not taught or suggested by Brobst.

In the "Response to Arguments" section of the Final Office Action in the parent applicant, the Examiner indicated that he interpreted the "originator" to be the "user." Applicant respectively submits that a misunderstanding occurred. The present application specifically distinguishes the "document originator" from the "user." More specifically, the specification explains on page 1, lines 11-13, that in the prior art "[n]either the originator or the author of the document or a user can prepare the document for easy printing when the document has several URL segments" (emphasis added). The specification similarly explains on page 3, lines 26-30 that "[t]he document print index 134 is explicitly specified by the document originator, and stored in the document root from which the other URLs in the document are linked." These

statements show that the document originator is the person, computer process, or entity that created the web page, and that user is the one that views the web page. Put more simply, the "originator" is not the "user."

Accordingly, Applicant respectively submits that claims 1-13, 16, and 19-26 are not anticipated by Brobst.

II. Claims 14-15 and 17-18

As first stated by Appellant in its Amendment dated November 29, 2002, both Brobst and Kelley were commonly owned by the assignee of the present application at the time the invention was made. In view of Appellant's filing of a Continued Prosecution Application ("CPA"), Appellant respectively submits that the changes made to 35 U.S.C. §103(c) by the American Inventors Protection Act of 1999 (AIPA) now apply. Accordingly, neither Brobst nor Kelley are available to support a rejection under §103(a).

Applicant has amended claims 14-15 and 17-18 to include the base claim and all intervening dependent claims. Therefore, Applicant respectively submits that claims 14-15 and 17-18 are now in condition for allowance.

9. Summary

For each of the foregoing reasons, it is submitted that the Examiner's rejections of claims 1-26 were erroneous, and reversal of his decisions is respectfully requested.

Date: November 25, 2003

Respectfully submitted,

By _____
Grant A. Johnson
Registration No.: 42,696

CERTIFICATE OF MAILING
UNDER 37 CFR 1.8(a)

I hereby certify that the enclosed or attached correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231, on November 25, 2003.

_____
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APPENDIX A (Claims)

1. A method for implementing web based document printing comprising the steps of:

obtaining a print index; said print index explicitly specified by a web based document author originator;

identifying uniform resource locators (URLs) in said print index; and

sequentially printing said URLs in said print index.

2. The method for implementing web based document printing as recited in claim 1 further includes the step of checking for a user selection of confirm print index option, and responsive to identifying said user selection of confirm print index option, performing a display and edit print index routine.

3. The method for implementing web based document printing as recited in claim 1 wherein the step of obtaining said print index includes the steps of checking for a user selection of whole print option, and responsive to identifying said user selection of whole print option, checking for a root tag present in the current page.

4. The method for implementing web based document printing as recited in claim 3 includes the steps of responsive to identifying said root tag present in the current page, switching to said root tag for printing.

5. The method for implementing web based document printing as recited in claim 1 wherein the step of obtaining said print index includes the steps of obtaining a kind of multi print to perform.

6. The method for implementing web based document printing as recited in claim 5 includes the steps of checking for a user selection of honor HTML, responsive to identifying said user selection of honor HTML, checking for a print index in the current page.

7. The method for implementing web based document printing as recited in claim 6 includes the steps of responsive to said print index in the current page, returning said print index.

8. The method for implementing web based document printing as recited in claim 6 includes the steps of checking for a user selection of print equal yes and anchor tags present in the current page, and responsive to identifying said user selection of print equal yes and anchor tags present in the current page returning scattered print.

9. The method for implementing web based document printing as recited in claim 8 includes the steps of responsive to not identifying said user selection of print equal yes and anchor tags present in the current page returning only current page print.

10. The method for implementing web based document printing as recited in claim 6 includes the steps of responsive to not identifying said user selection of honor HTML, checking for a user selection of print index.

11. The method for implementing web based document printing as recited in claim 10 includes the steps of responsive to identifying said user selection of print index, checking for a print index present in the current page.

12. The method for implementing web based document printing as recited in claim 11 includes the steps of responsive to identifying said print index present in the current page, returning said print index.

13. The method for implementing web based document printing as recited in claim 12 includes the steps of responsive to identifying said print index present in the current page, returning only current page print.

14. A method for implementing web based document printing comprising:

obtaining a print index; said print index explicitly specified by a web based document originator;

identifying uniform resource locators (URLs) in said print index;

sequentially printing said URLs in said print index;

checking for a user selection of honor HTML, responsive to identifying said user selection of honor HTML, checking for a print index in the current page;

responsive to not identifying said user selection of honor HTML, checking for a user selection of print index;

responsive to not identifying said user selection of print index, checking for a user selection of scattered print and responsive to identifying said user selection of scattered print, returning scattered print; and

wherein obtaining said print index includes obtaining a kind of multi print to perform.

15. A method for implementing web based document printing comprising:

obtaining a print index; said print index explicitly specified by a web based document originator;

identifying uniform resource locators (URLs) in said print index;

sequentially printing said URLs in said print index;

checking for a user selection of honor HTML, responsive to identifying said user selection of honor HTML, checking for a print index in the current page;

responsive to not identifying said user selection of honor HTML, checking for a user selection of print index;

responsive to not identifying said user selection of print index, checking for a user selection of manual print and responsive to identifying said user selection of manual print, returning manual print; and

wherein obtaining said print index includes obtaining a kind of multi print to perform.

16. The method for implementing web based document printing as recited in claim 5 includes the steps of checking for an existing print index, and responsive to identifying said existing print index, returning said existing print index.

17. A method for implementing web based document printing comprising:

obtaining a print index; said print index explicitly specified by a web based document originator;

identifying uniform resource locators (URLs) in said print index;

sequentially printing said URLs in said print index;

checking for a scattered print option, and responsive to identifying said scattered print option, creating a print index from scattered anchor tags marked print equal to yes; and

wherein obtaining said print index includes obtaining a kind of multi print to perform.

18. A method for implementing web based document printing comprising:

obtaining a print index; said print index explicitly specified by a web based document originator;

identifying uniform resource locators (URLs) in said print index;

sequentially printing said URLs in said print index;

checking for a manual print option, and responsive to identifying said manual print option, manually creating a print index; and

wherein obtaining said print index includes obtaining a kind of multi print to perform.

19. The method for implementing web based document printing as recited in claim 5 includes the steps of creating a print index containing only the current page.

20. The method for implementing web based document printing as recited in claim 1 includes the steps of identifying a user selection of level first and creating a print index to print highest level orders first.

21. The method for implementing web based document printing as recited in claim 1 includes the steps of identifying a user selection of branch first and creating a print index to sequentially print each branch.

22. Apparatus for implementing web based document printing comprising:

a stored document print index, said print index explicitly specified by a web based document originator; said document print index including a list of user selected uniform resource locators (URLs) to be printed; and

a web based printing program utilizing said stored document print index for printing a document including said list of user selected uniform resource locators (URLs).

23. Apparatus for implementing web based document printing as recited in claim 22 includes a scattered print specification, said scattered print specification including a URL print control function with HTML elements.

24. Apparatus for implementing web based document printing as recited in claim 23 includes a print order number and a print order control.

25. A computer program product implementing web based document printing comprising:

a recording medium;

means, recorded on the recording medium, for storing a print index, said print index explicitly specified by a web based document originator; said print index including a list of user selected uniform resource locators (URLs) to be printed;

means, recorded on the recording medium, for obtaining said print index and for printing a document including said list of user selected uniform resource locators (URLs).

26. The computer program product implementing web based document printing as recited in claim 25 includes means, recorded on the recording medium, for identifying a user selected scattered print specification and means, recorded on the recording medium, for identifying URLs with HTML elements having anchor tags of a user selection of print equals yes and for printing a document including said URLs with HTML elements having anchor tags of said user selection of print equals yes.